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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,393	12/07/2001	Ken Lang	KLQ-001	4473
959	7590	05/03/2006	EXAMINER	
LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/010,393	<b>Applicant(s)</b> LANG, KEN	
	<b>Examiner</b> Merilyn P Nguyen	<b>Art Unit</b> 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01/26/2006.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-54 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed action</u> .                  |

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### DETAILED ACTION

1. In response to the communication dated 01/26/2006, claims 1-54 are active in this application.
2. This application claims US Provisional Application 60/254038 filed on 12/07/2000.

### *Acknowledges*

3. Receipt is acknowledged of the following items:  
  
The applicant's amendments filed on 01/26/2006 have been considered.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-35 and 41-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Sui (WO 01/29747).

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Regarding claims 1 and 41, Sul discloses in an electronic device, a method, comprising the steps of:

- providing user profiles regarding users and fitness activities of the users (See page 13, line 13 to page 14, line 16, wherein user profiles stored in database and is searched by a joining member to a team and wherein users obtain memberships by accessing the website through the internet and input general information including an area where a sporting event will be placed, ages, the type of a sporting event, level of skill so that these information is classified and stored in database [see page 12, lines 1-24]); and
- examining the user profiles to match at least two selected ones of the users (matching member to searched team, See page 14, line 1-10 and matching teams based on information in the database, See page 19, lines 1-7) for a scheduled fitness activity based on the user profiles of each of the selected ones of the users (See page 18, lines 8-15 and page 19, lines 1-7).

Regarding claims 2 and 42, Sul discloses informing a first of the selected users of the scheduled fitness activity (See page 20, lines 6-10).

Regarding claims 3 and 43, Sul further discloses sending an invitation to participate in the scheduled fitness activity to the first selected user (See col. 15, lines 20-29).

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Regarding claims 4 and 44, Sul wherein the invitation includes a user interface component for enabling the first selected user to accept or decline the invitation (See Fig. 8).

Regarding claims 5 and 45, Sul further discloses sending a communication to the second selected user informing the second selected user whether the first selected user accepted or declined the invitation (See page 16, lines 1-11).

Regarding claims 6 and 46, Sul discloses wherein calendars of fitness activities are maintained for the selected users and wherein the method further comprises the step of adding the scheduled fitness activity to the calendars of the selected users (See page 16, lines 27-28).

Regarding claim 7, Sul discloses wherein the selected users have client devices with displays and wherein the client devices communicate with the electronic device and wherein the method further comprises the step of displaying the calendar for at least one of the calendars on the display of at least one of the client devices (See page 18, lines 9-15).

Regarding claim 8, Sul discloses wherein the electronic device is a computer system (See page 18, lines 13-15).

Regarding claim 9, Sul discloses wherein the step of examining is prompted by one of the selected users requesting the scheduling of the scheduled fitness activity (See page 13, line 16-18).

Regarding claim 10, Sul further discloses providing a user interface element for specifying which of the users to invite to the scheduled fitness activity (See page 14, lines 1-3).

Regarding claim 11, Sul discloses wherein the user interface element is part of a web Page (See page 14, lines 1-3).

Regarding claim 12, Sul further discloses providing a user interface component for specifying a date, time and place for the scheduled fitness activity (See page 18, line 26 to page 19, line 7).

Regarding claim 13, Sul discloses wherein the user interface component for specifying a date, time and place is part of a web page (See Fig. 8).

Regarding claim 14, Sul discloses providing a user interface component for identifying what type of fitness activity the scheduled fitness activity is (See fig. 6, "type of game").

Regarding claims 15 and 47, Sul discloses a method performed in an electronic device, the method comprising the steps of:

- providing a user interface (website) that enables a user to request a suitable partner for a fitness activity (See page 13, lines 16-17);

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- conducting a search of candidate partners to locate a suitable partner (See page 13, line 16 to page 14, line 10); and
- returning to the user (member) a list of any suitable partners (“the searched team is output to a screen of the website”, See page 14, lines 1-2, wherein team having plurality of suitable partners (members of the team)).

Regarding claims 16 and 48, Sul discloses wherein the user interface enables the user to specify characteristics of a suitable partner (See page 14, lines 8-10).

Regarding claims 17 and 49, Sul discloses wherein the search looks for candidate partners having the specified characteristics (See page 4, lines 21-26).

Regarding claims 18 and 50, Sul discloses wherein only candidate partners matching at least some of the specified characteristics are set forth on the list (See 14, lines 8-10).

Regarding claims 19 and 51, Sul discloses wherein the user interface enables the user to specify suitable ages as one of the characteristics for a suitable partner (See page 4, lines 21-22).

Regarding claims 20 and 52, Sul discloses wherein the user interface enables the user to specify a suitable geographic locale as one of the characteristics for a suitable partner (See page 4, lines 21-22).

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Regarding claims 21 and 53, Sul discloses wherein the user interface enables the user to specify a suitable skill level at the fitness activity for suitable partners (See page 4, lines 22-23).

Regarding claim 22, Sul further discloses receiving at least one user choice from the list of suitable partners; and sending an invitation communication to the user choices to participate in the fitness activity (See page 4, lines 23-26).

Regarding claim 23, Sul discloses wherein the user interface is provided to the user via a network (See page 12, lines 16-25, wherein user interface is a website which is provided to the user via a network).

Regarding claim 24, Sul discloses wherein the network is a computer network (See page 18, lines 10-15).

Regarding claim 25, Sul discloses wherein the computer network is the Internet (See page 14, lines 1-2).

Regarding claim 26, Sul discloses a method performed in a computer system, the method comprising the steps of:

- o providing a web site (See page 3, lines 4-5, Sul establishes a sport website on Internet) having:

a matching facility for identifying persons (teams having plurality of members/players) that are well-matched to a first user for a particular type of fitness activity (See page 4, lines 21-26 and page 13, line 16 to page 14, line 10, Sul teaches matching facility as Sul discloses searching and outputting the matched team(s) to joining members, wherein team including plurality of players) based on user profiles for the user and well-matched persons (matching information ["user profile"] of a member to information ["user profile"] of searched team [page 14, line 1-10] or matching teams based on information in the database [page 19, lines 1-7])

a scheduling facility (Fig. 3) for scheduling fitness activities among persons (See page 16, line 1-11, "the type of an arrangement or the schedule of the arrangement with a counterpart is processed by an administrator by using an automatic arrangement program");

using the matching facility to identify at least one person that is well-matched to the user for a first type of fitness activity (sporting event) (See page 4, lines 21-26 and page 13, line 16 to page 14, line 10) based on the user profiles for the user and the at least one well-matched person identified (page 14, lines 1-10 and page 19, lines 1-7); and

using the scheduling facility to schedule a first event of the first type of fitness activity between participants, including the first user and the well-matched person (See page 16, line 1-11).

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Regarding claim 27, Sul further discloses sending electronic reminders to the participants of the scheduled first event of the first type of fitness activity (See page 20, lines 5-9).

Regarding claim 28, Sul further discloses receiving a communication indicating that a selected one of the participants can no longer participate in the first event of the first type of fitness activity (“the member intimates intention not to participate in the set of game”); and adjusting the scheduling of the first event of the first type of fitness activity with the scheduling facility to indicate that the selected participant will not participate. Please see page 18, lines 17-21.

Regarding claim 29, Sul further discloses:

- receiving a communication requesting cancellation of the first event of the first type of fitness activity;
- in response to the communication, canceling the first event of the first type of fitness activity with the scheduling mechanism. Please see page 18, lines 17-21.

Regarding claim 30, Sul further discloses sending electronic notification to each of the participants of the first event of the first type of fitness activity that the first event of the first instance of the first type of fitness activity has been cancelled (See page 20, lines 10-15).

Regarding claim 31, Sul further discloses:

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- receiving a communication requesting a change in the first event of the first type of fitness activity (See col. 16-21);
- in response to the communication, modifying scheduling of the first event of the first type of fitness activity(See col. 16-21); and
- sending electronic notifications to the participants to inform the participants of the modifying of the scheduling of the first event of the first type of fitness activity (See col. 5, lines 5-9).

Regarding claim 32, Sul further discloses providing participants with an option of designating whether the participants wish to continue to participate in the first event of the first type of fitness activity in view of the modifying of the scheduling (See page 15, line 23 to page 16, line 11).

Regarding claim 33, Sul further discloses using the scheduling facility to schedule a second event of the first type of fitness activity (See page 18, lines 16-21).

Regarding claim 34, Sul discloses wherein the second event is scheduled for a second user (See page 20, lines 10-15).

Regarding claim 35, Sul further discloses using the scheduling facility to schedule a third event of a second type of fitness activity (See page 17).

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5. Claims 36-40 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Browne (US 5,598,849).

Regarding claims 36 and 54, Browne discloses a method performed in an electronic device, the method comprising the steps of:

- prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity (See col. 11, lines 29-39 and claim 12, wherein “a participant” corresponding to “personal trainer”);
- in response to the prompting, obtaining the feedback regarding the selected participant (See col. 1, lines 30-33); and
- making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant (See abstract and col. 12, line 66 to col. 13, line 34).

Regarding claim 37, Browne further discloses making feedback from other participants of the fitness activity regarding the selected participant available to the parties (See col. 11, lines 30-39).

Regarding claim 38, Browne further discloses making additional feedback from other fitness activities regarding the selected participant available to the parties (See col. 11, lines 30-39).

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Regarding claim 39, Browne discloses wherein the prompting is performed over a computer network (See Fig. 5)

Regarding claim 40, Browne discloses wherein the information regarding the feedback is made available over a computer network (See Fig. 5 and col. 13, lines 1-23).

### ***Response to Arguments***

6. Applicant's arguments filed 01/26/2006 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive.

#### **Independent Claims 1 and 41:**

Applicant's argument:

"Sui does not disclose matching a first user with a second user based on the user profiles of each user. The passage of Sui cited by the Examiner discloses member searching for a sports team to join. This is not the same as being matched with another member for an activity based on the profile of each member. Indeed Sui makes no disclosure whatsoever of being able to match a first user with a second user for a non-team sport activity, like hiking, based on the profiles of each user as set forth in the present application. Thus Sui fails to disclose examining the user profiles to match at least two selected ones of the users for a scheduled fitness activity based on the user profiles of each of the selected ones of the users".

Examiner's response:

Examiner respectfully disagrees with Applicant's argument. Sui teaches users obtaining memberships by accessing the website through the internet and inputting general information

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including an area where a sporting event will be placed, ages, the type of a sporting event, level of skill so that these information is classified and stored in database [see page 12, lines 1-24], wherein these information corresponds to “user profiles” and is searched for joining member to a team (page 13, line 13 to page 14, line 16). Sui teaches examining the user profiles to match at least two selected ones of the users as matching member to searched team (page 14, line 1-10) or matching teams based on information in the database (page 19, lines 1-7) for a scheduled fitness activity based on the user profiles of each of the selected ones of the users (page 18, lines 8-15 and page 19, lines 1-7). Table 1 (page 12) and Table 2 (page 13) disclose information (“user profile”) of members and the team name that members belong to. Because Sui requires user for obtaining membership in order to join teams and information (“user profile”) of member stored in the database is used to match with information (“user profile”) of members of variety of teams in order to provide suitable team/teams to member, thus Sui clearly teaches matching at least two selected ones of the users for a scheduled fitness activity based on the user profiles of each of the selected ones of the users.

Claims 2-14 and 42-46 depend from claims 1 and 41 respectively and incorporate each and every element of claims 1 and 41 and thus rejected as the same.

**Independent claims 15 and 47:**

Applicant’s argument:

“Sui does not disclose providing a user interface that enables a user to request a suitable partner for a fitness activity. Instead, Sui provides a user interface that allows a user to find a find a suitable sports team to join. The user interface of Sui is used to set up or find a sports team to

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join. This is not the same as allowing a user to request a suitable partner for a fitness activity.

Sui allows for searching to find a team to join. As such, the user interface of Sui does not enable a user to request a suitable partner. Therefore, Sui fails to teach or suggest providing a user interface that enables a user to request a suitable partner for a fitness activity”.

Examiner’s response:

Examiner respectfully disagrees. Sui teaches a user interface (website) that enable member to request a suitable partner for a fitness activity as member can searching to find suitable team(s) to join (See page 13, line 16 to page 14, line 10). One having ordinary skill in the art would have recognized that team comprising plurality of members thus having at least one partner.

Therefore, matching a member to team(s) means matching to at least one suitable partner for a fitness activity.

Claims 16-25 and 48-53 depend from claims 15 and 47 respectively and incorporate each and every element of claims 15 and 47 and thus rejected as the same.

**Independent claim 26:**

Applicant’s argument is similar to claims 1 and 41, thus is addressed the same as above.

Claims 27-35 depend from claim 26 and incorporate each and every element of claim 26 and thus rejected as the same.

**Independent claims 36 and 54:**

Applicant’s argument:

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“Browne is not directed to a method or system like the present invention where “fitpals” are matched for a fitness activity. As such there is no need for a means to provide feedback on fellow participants in a fitness activity because participants aren't being matched to participate in a fitness activity.”

Examiner's response:

Examiner respectfully disagrees, the Applicant argues on the recitation that is not claimed. There is no matching function recited in the claim. What's being claimed, “prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity”, does not required “fitpals” are being matched for playing a game. “A fitness activity” is broadly enough to express any activity related to fitness. The Examiner points out that, “a participant” corresponds to “personal trainer” and “a selected participant” corresponds to exerciser of Browne. Because of “personal trainer” is a physical instructor responsible for the exercise progress of his designated users (exercisers) (See col. 11, lines 18-20), both “personal trainer” and exercisers participates in activity relating to fitness.

Applicant argues:

“Browne fails to disclose prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity. Browne discloses preparing a report on the user and providing a voice recording mechanism for personal trainer to leave comments for a user”.

Examiner's response:

Examiner respectfully disagrees. As pointed above by Applicant, Browne discloses providing a voice recording mechanism for personal trainer to leave comments for a user. Providing a voice

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recording mechanism enable (prompting) the personal trainer to leave comments (feedback) for a user (selected participant).

Applicant argues:

“Browne does not disclose prompting the personal trainer for feedback such as disclosed form 380 in Figure 15 in the present application”. The Applicant is respectfully noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues:

“Browne also fails to disclose obtaining feedback in response to the prompting.”

Examiner's response:

Examiner respectfully disagrees. Browne teaches obtaining feedback in response to the prompting as personal trainer places comments (feedback) by recording voice messages for each user in the master data processor 101 so that the voice message may be delivered to the user (See col. 11, lines 40-46).

Applicant argues:

“Browne also does not disclose making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant”.

Examiner's response:

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Examiner respectfully disagrees. Since the recited limitation does not clarify if “a fitness activity” is different than “a fitness activity” introduced previously in the claim and Browne teaches information regarding the feedback available to parties (See col. 13, lines 29-34), one having ordinary skill in the art would have recognized that information regarding the feedback is made available for everyone.

Claims 37-40 depend from claim 37 and incorporate each and every element of claim 37 and thus rejected as the same.

#### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 571-272-4026.


The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN 

April 11, 2006

  
DON WONG  
SUPERVISORY PATENT EXAMINER